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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,822	01/23/2002	Volkmar Schwitzky	103797-238-NP	9521

24964 7590 02/11/2005

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/055,822

Applicant(s)

SCHWITZKY ET AL.

Examiner

Frederick J. Parker

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments in response to the objection to the title of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is necessitated by amendment.

- Claim 1, line 4, "printed security sheet" lacks proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1,6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Weitzberg et al US 3533176.

Art Unit: 1762

Weitzberg teaches to apply a transparent protective sealing lacquer layer over a tamper-proof security document on which is applied a watermark (col. 3, 10-17; col. 4, 42). Claim 1 as amended now merely requires partially coating a portion of a security sheet bearing a watermark, and lacquering the full sheet to increase durability which may be done in one or more steps. Since lacquering of the entire surface is done across the face, rather than instantaneously coating the entire face, the coating of the watermark followed by the complete coating of the card would have been inherent since watermark 2 is located on the interior of the sheet surface. Alternatively, it would have been obvious to coat across the surface of the sheet so that the watermark would have been lacquered prior to coating the entire security sheet. Since both reference and claim 1 lacquers the watermark, there would have been the expectation that the enhanced transparency of the watermark would have been inherent, since Applicants claims never require anything more specific than applying a layer of lacquer to the watermark, as does Weitzberg et al. The mere observation of another and inherent beneficial result of a known process cannot form the basis of patentability, *Allen v. Coe* 57 USPQ 136 & *In re Maeder et al* 143 USPQ 249.

7. Claims 1,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haghiri et al US 5888624 in view of Gundjian US 5290068.

Haghiri et al teaches an IC card ("sheet") with printed images and security elements including watermarks (col. 9, 51-52), to which is applied a lacquer layer (gloss, matte, grained) by a spreading unit, col. 9, 15-54, over all faces and edges (the "whole surface" of the card) to **provide protection and prevent splitting**. Partially coating the watermark would have been an

Art Unit: 1762

obvious progression as the whole surface of the card / sheet is coated with lacquer by the spreading unit since the watermark would be located on a major surface. Applying lacquer to increase transparency is not expressly cited.

Gundjian teaches to secure substrates against counterfeiting, copying, and FAX transmission using a series of security elements. In the embodiments on col. 7, 15-26, it is recognized that the application of lacquer to a surface adds “gloss to the surface..., since specular reflection characteristics... enhance uncopiability of the final product”. Thus, the reference fairly teaches to reduce copiability of security documents by application of suitable lacquer to form a reflective gloss. Since both references are directed to ways of improving security of documents, the importance of preventing critical security elements, such as the watermark of Haghiri et al, from being reproduced using a separate gloss lacquer coat as disclosed by Gundjian would have been an obvious improvement to enhance security of the document. The reference is not limited by gloss lacquer type and would have included conventional colorless gloss lacquers, per claim 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Haghiri et al by applying a suitable lacquer coating to add gloss/ specular reflection characteristics as taught by Gundjian to the surface of watermarks of Haghiri et al to prevent reproduction and transmission of the security documents.

### ***Response to Arguments***

8. Applicants amendments and arguments have been considered.

Applicants argue on page 5 of response that the issues of low visibility or identifiability of watermarks on security sheets are not addressed. However, the Applicants are reminded that

Art Unit: 1762

Haghiri et al and Weitzberg et al already lacquer the watermarks on the security sheets, so that one would have reasonably expected that enhanced visibility/ identifiability of the watermarks would have already been apparent. There is no apparent difference between Applicants lacquering of the watermarks and that of the prior art (Haghiri et al or Weitzberg et al), so why would one have reasonably expected a problem of visibility/ identifiability of the watermarks in either case? Or, for that matter, why would lacquering of watermarks in the prior art produce different visual effects than in the process as claimed by Applicants? Certainly, lacquering of any surface, e.g. grained wood, is to not only provide a protective surface but to “visibly bring out” the structure of the underlying material. The Examiner additionally introduced Gundjian in the last Office Action to further show the known role of lacquering of security documents to improve gloss and security effects. Applicants argue the prior art deals with unrelated problems, but in fact the lacquering of both prior art references provides a “protective layer” which is the same as Applicants’ limitation of “increasing... durability”. The visual emphasis of the watermarks by lacquer would have been inherent to the prior art processes. The mere observation of another inherent beneficial result of a known process cannot form the basis of patentability, *Allen v. Coe* 57 USPQ 136 & *In re Maeder et al* 143 USPQ 249.

Applicants arguments are therefore not deemed to be persuasive, and rejection of claims 1,6 as amended are maintained.

Art Unit: 1762

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

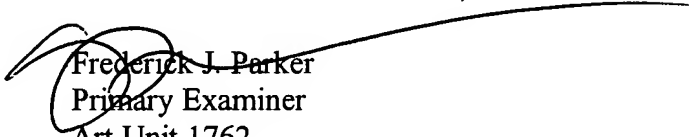
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571/272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp